Supreme Court, U.S.
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In The
United States Supreme Court
October Term, 1995

BADER'S DUTCH BISCUIT CO., INC., a Washington corporation,

Plaintiff-Respondent,

v.

HEARTHSIDE BAKING CO. d/b/a MAURICE LENELL COOKING COMPANY, an Illinois corporation,

Defendant-Petitioner.

Appeal from the Western District of Washington at Seattle
Civil Action No.: C 94-726R
The Honorable
Barbara Rothstein and Walter McGovern,
Judges Presiding.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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QUESTIONS PRESENTED

1. Whether there should exist a conflict between the several Circuits as to whether the presence of Defendant-Petitioner's name permanently and prominently displayed upon its packaging should preclude a finding of "likelihood of confusion" and trade dress infringement under the Lanham Act and pursuant to the prevalent law in several of the Circuits?

2. Whether the record supports a finding of "likelihood of confusion" and trade dress infringement where Defendant-Petitioner redesigned its packaging using different artwork by a different artist and the only common elements consisted of a two-by-two configuration of containers and functional cardboard surround?

RULE 29.1 STATEMENT

Petitioner is HEARTHSIDE BAKING COMPANY d/b/a MAURICE LENELL COOKING COMPANY, (hereinafter, "Maurice Lenell"). Pursuant to Supreme Court Rule 29.1, Petitioner states that it has no parent or subsidiary company.

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No. 95 -

IN THE SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1995

Bader's Dutch Biscuit Co., Inc.,
Respondent,
v.
Hearthside Baking Co. d/b/a
Maurice Lenell Cooking Company,
Petitioner.

Petition For A Writ of Certiorari To The United States Court Of Appeals For The Ninth Circuit

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PETITION FOR A WRIT OF CERTIORARI

Defendant-Petitioner, HEARTHSIDE BAKING COMPANY d/b/a MAURICE LENELL COOKING COMPANY, (hereinafter, "Maurice Lenell") respectfully petitions for a Writ of Certiorari to review the judgment of the United States Court of Appeals for the Ninth Circuit, entered in this proceeding on August 18, 1995, the denial of Petitioner's Petition for Rehearing entered on September 27, 1995, and the District Court's Orders of September 9, October 7, and October 9, 1994, which were affirmed in the Ninth Circuit's Order of August 18, 1995.

OPINION BELOW

The prior opinion in this case was entered by the United States Court of Appeals for the Ninth Circuit in an unreported opinion (C.A. No. 94-36048), a copy of which is

attached in the Appendix at 1a following opinion, the Court denied Petitioner's Petition for Rehearing. A copy of this Order is found at 5a.

JURISDICTION

This matter is filed within 90 days following the entry of the Order denying Petitioner's timely Petition for Rehearing, in accordance with 28 U.S.C. § 1257(a). Federal subject-matter jurisdiction arises under 15 U.S.C. §1125(a) and appellate jurisdiction arises under 28 U.S.C. §1292(a), permitting an appeal from the grant of a preliminary injunction.

STATEMENT OF THE CASE

This is a case of national significance as a result of a lower court's ruling that allows a local cookie company in Seattle to be the only company in the United States that is permitted to market cookies in a four-pack of decorative tins in a two-by-two configuration. Additionally, the Ninth Circuit's decision creates a conflict between the circuits which cannot be reconciled with the decision in *Conopco, Inc. v. Mays Department Stores Company*, 46 F.3d 1556 (Fed. Cir. 1994) 32 U.S.P.Q. 2d 1225, cert.denied __ U.S. __, __ S. Ct. __, __ L.Ed.2d __, 55 CCH S. Ct. Bull. B 1305 (April 17,1995); *August Storck K.G. v. Nabisco, Inc.*, 55 F.3d 1300 (7th Cir. 1995); *Merriam-Webster, Inc. v. Random House, Inc.*, 35 F.3d 65 (2nd Cir. 1994); *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033 (2nd Cir. 1992); and *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1131 (Fed. Cir. 1993).

Review of the Ninth Circuit's decision is urgently needed. If § 43 of the Lanham Act is not applied uniformly

throughout the country then there can be no predictable way to ascertain before a product is placed on the market whether that product will infringe upon the trade dress of some other, possibly purely local product. (See 15 U.S.C. § 1125(a), hereinafter, "§ 43".) Without a uniform application of the Lanham Act, local Courts can protect local businesses to the detriment of competing businesses in the nation as a whole. Under the law of other Circuits, including the Federal Circuit applying the law of the Sixth Circuit, a product does not infringe so long as the brand name is prominently and permanently displayed thereon. The Ninth Circuit appears to hold differently, and the uncertainty as to what is allowed and allowable upon packages could adversely effect the flow of commerce throughout the United States.

This case arises out of a complaint filed in the United States Court for the Western District of the Ninth Circuit in Seattle, Washington, on May 12, 1994, by Plaintiff-Respondent, BADER'S DUTCH BISCUIT CO., INC., ("Bader's"), alleging that Maurice Lenell and other parties not involved in this Petition engaged in conduct which violated the Lanham Act and the Washington State Consumer Protection Act. (See R.C.W. 19.86.010, hereinafter, "Washington State Consumer Protection Act".)

Background

Plaintiff's Complaint alleges that Defendant, Maurice Lenell and other Defendants not involved in this appeal, committed a violation of § 43 of the Lanham Act by *inter alia*, attempting to market cookies in decorative collectors' tins. The Complaint claimed that Bader's president, Stephanie Chilton, "conceived the idea" of marketing Plaintiff's cookies in "decorative tins", in the year

1989. (See Designated Record filed with the Ninth Circuit, hereinafter "R", with the document number designated as "Doc."; see Complaint, paragraph 9, R, Doc. 1.)

The Complaint further claimed that Plaintiff's president "began work with a graphic artist", and began to package the cookies in tins. The Complaint also claims that as a result of the change in packaging, Bader's cookie sales increased four-fold. (See Complaint, paragraphs 10 and 12, R, Doc. 1.)

Plaintiff further contends that Defendant Maurice Lenell, along with other Defendants, created trade dress that allegedly, "is a virtual copy of the distinctive trade dress", consisting of the decorated cookie tins used by Plaintiff. Finally, Plaintiff alleges that Defendant attempted to solicit Plaintiff's customers by using the purportedly distinctive trade dress used by Plaintiff. (See Complaint, paragraph 16, R, Doc. 1.)

The Preliminary Injunction Hearing of August 30, 1994.

On May 12, 1994, Plaintiff moved for a preliminary injunction to be imposed against Defendant Maurice Lenell. On August 1, 1994, Defendant Maurice Lenell filed its Response and Opposition to Plaintiff's Motion. (R, Doc. 32.) Plaintiff's Motion was heard on August 30, 1994, before Judge Walter McGovern. (See R, Doc. 64, Transcript of August 30, 1994, hereinafter, "TR".)

At this hearing, Plaintiff presented as its sole witness, Stephanie Chilton, the president of Plaintiff corporation. Plaintiff offered the Court no supporting documentary evidence. By contrast, Defendant presented five witnesses and were ready to present four more

witnesses who were not able to testify as a result of limited time parameters set by Judge McGovern for the hearing. In addition, Defendant Maurice Lenell offered twenty-six exhibits which were received into evidence.

At the commencement of the hearing, Plaintiff characterized the instant action as ..."a case of trade dress and trademark infringement." [1] (TR 5.) Also, Plaintiff's council stated in her opening statement, *inter alia*, that "the question is whether or not the defendant ...has adopted a trade dress that is so similar to the trade dress that's been used by ...Bader's so as to cause the customers and the public to believe that their product originates from Bader's" (TR 5.) She also argued that the basic question of law is whether there is confusion between Bader's product and that of Maurice Lenell. Further, she admitted that it is not Plaintiff's position that it owns the exclusive right to use Victorian art and that the packaging or its configuration was *not* an issue. (TR 6-7.) She stated that the issue is trade dress and the nature of the art. (TR 7.)

In Defendant Maurice Lenell's opening argument, its attorney noted that Plaintiff's statement that Defendant had purchased from Mr. Braun, certain copyrights of the artwork produced for Bader's was incorrect, and that Maurice Lenell did not purchase the copyrights and had no intention of producing that which Bader's had produced. Maurice Lenell also argued that Victorian art is used throughout America on similar products, such as candy popcorn and peanuts, and that Bader's packaging is typical and is required by chain store customers that sell in large quantities such as Sam's Warehouse. Additionally Maurice

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[1] Plaintiff has since amended the Complaint, proceeding solely upon the claims for trade dress infringement and violation of the Washington Consumer Fraud Act.

Lenell asserted that there are significant differences between the decorative tins and packaging including the presence of labels on both products. (TR 9-10.)

Defendant presented uncontroverted testimony from Plaintiff's former sales and marketing manager, Robert Gray, who testified that Bader's four-pack was developed in response to the requirements of Sam's. Gray testified that the tin and Victorian artwork were normal Christmas decorative tins and artwork used by companies other than Bader's, for popcorn, peanuts, candy and cookies. (TR 34-37, 39.)

Gray further testified that it is normal in the cookie industry to take cookie tins and sell them in four-packs. (TR 35.) Gray indicated that the four-pack shrink-wrap cookie tins were first sold to Price-Costco and Sam's in 1992. (TR 43.) Gray indicated that other cookie companies that sold the same type of Christmas Victorian tins were Parco, Houston Foods, and Holiday Delight. (TR 45-49.)

Additional uncontroverted testimony was provided by witness Andrew Gole, a tin broker who produced Maurice Lenell's decorative tins and who testified pursuant to subpoena. He stated that the tins produced for Maurice Lenell were smaller in diameter than those of Bader's. He testified that neither Plaintiff nor Defendant has a distinctive trade dress since both cans rely upon "public domain artwork", which is available to everyone. (TR 62-65.). Gole identified Defendant's Exhibit 13 as several cans his company produced and one that was a mock-up of a new idea. The cans were for various products, and several featured Victorian-style artwork. He stated, on questioning both by Defendant's counsel and the District Court, that the multiple pack packaging was common at all levels of

the distribution chain. He stated he has seen four and three-packs most frequently. (TR 65-71.)

Other testimony presented by Defendant which was not controverted by Plaintiff established that at least one other cookie manufacturer other than Bader's or Maurice Lenell, sold cookies in the same sized tin. (TR 72-76.) Other testimony demonstrated that Victorian art was a common and popular feature of many types of decorative tins throughout not only the United States, but in other countries as well. Also, the four-pack configuration used by both Plaintiff and Defendant was a standard package required by warehouse club stores and that Danish cookies and other snack foods are sold in four-packs. (TR 76-80.)

The last witness Maurice Lenell was permitted by Judge McGovern to call was Terry Cohen, the chief executive officer of Maurice Lenell. He testified that Maurice Lenell has used Victorian artwork on various-sized tins prior to the tins complained of and then identified various tins from different catalogues as decorative tins Maurice Lenell used in the past. (TR 89-92.) Cohen testified that in the past Archway and Parco, were two cookie companies that used Victorian art on similarly-sized tins. (TR 94.)

Cohen's testimony demonstrated that Maurice Lenell developed its four-pack in response to requests from its client, Sam's. (TR 96.) Cohen stated that Maurice Lenell's cookies would not be sold together with Bader's since Sam's buys only one type of item at a time and does not purchase the same type of item from different bakers. Sam's Warehouse was the only customer to whom Maurice Lenell had sold the four-pack configuration. (TR 95-6.)

On September 2, 1994, using a form prepared by Plaintiff's counsel, Judge McGovern entered an Order imposing a preliminary injunction upon Defendant. Attached to the Order was a photograph of one of Bader's Easter tins which was *never* a part of the instant dispute. Not only does the record fail to show any evidence or testimony concerning Easter tins, but it is beyond dispute that Maurice Lenell did not at that time produce any specialty Easter tins for its shortbread cookies. Further, the Order enjoined Maurice Lenell from using Ray Braun as an artist without any evidence being presented which would tend to show that *all* artwork produced by Mr. Braun would necessarily be "confusing" within the meaning ascribed by § 43. (22a, 24a.)

On September 9, 1994, Judge McGovern entered findings of fact setting forth his reasons for imposing the preliminary injunction. (R 32.)

Hearing of October 7, 1994

As a result of Judge McGovern's Order of September 2, Maurice Lenell redesigned its tins. On October 7, there was a hearing on Defendant's Motion for approval of its redesigned tins. Instead of Christmas scenes, Maurice Lenell used winter scenes which had been in use by Maurice Lenell for a number of years prior to that time. (See Transcript of October 7, 1994, hereinafter, "TR2", pages 1-5.) Terry Cohen testified at the hearing that Sam's required four one-pound cookie tins to meet its price point of $7.50. He explained that the cardboard container that housed the cookie tins was required by Sam's because the four-pack is sold on pallets which require the decorative tins to be viewed by the public with a shrink-wrap to hold the packages together. In addition, he explained that the cardboard

packaging was used both for shipping, handling, and to provide an area for "shelf talk". (TR2 pages 10-13.)

Terry Cohen testified as to the differences in the redesigned artwork on the tins. He testified that none of the designs were designed by Ray Braun, and that the colors, composition, sizes and configurations of the images were different from Defendant's preceding set of tins. He stated that the only customer to whom these four-packs were sold were Sam's and that the size of Maurice Lenell's tin is different than Bader's tin. (TR2 pages 13-2.) Cohen further testified that Maurice Lenell has its name on its product and packaging, and Bader's does not, [although they use the name Baker's Estate], and the colors are different. (TR2 page 23-26.)

At the end of the hearing Terry Cohen was recalled to testify regarding the necessity for the four-pack packaging configuration of the tins. He explained that there needed to be a lip for stability of the tray. He further stated that the packaging was designed specifically for club stores and that the entire multi-pack was configured to fit a 40 × 48 pallet. He also testified that not only was the cellophane necessary to keep the four tins in the tray, but that it provided insulation, preventing the tins from rubbing and scratching each other. (TR 2, pages 71-74.)

Maurice Lenell also presented the testimony of Richard Papera, a tin manufacturer. The Court allowed the filing of Richard Papera's declaration. (TR2 40.) Papera further testified that Aparco Foods, a cookie company from Chicago, used a similar tin and four-pack with Christmas designs a number of years ago, and that Victorian art designs similar to those used by Bader's have been sold to popcorn and candy companies with the same format of

packaging for years. (TR2, pages 40-43.)

District Court Orders

On September 2, 1994, Judge McGovern entered an Order imposing a preliminary injunction prohibiting Maurice Lenell from using certain images and artwork on its packages; on September 9, 1994, Judge McGovern entered related findings (See Order of September 9, 1994 at 13a.); On October 11, 1994, Judge McGovern denied Maurice Lenell's Motion for a Reconsideration of the prior Orders, and granted Defendant's Motion for a bond, but only required a bond of $10,000.00, when a bond of $7 million was requested (See Order of October 11, 6a.); On October 7, 1994, Judge Rothstein entered an Order denying Maurice Lenell's Motion for Approval of Certain Redesigned Cookie Tins, based upon its two-by-two four-pack packaging which the Court viewed a an enforcement of the preliminary injunction and gave Plaintiff the exclusive right to be the only cookie company in America to use a two-by-two four-pack for packaging four cookie tins. Up to this point in time, packaging was not an issue. The Court agreed that the winter scenes did not infringe upon Bader's trade dress, but that the similar packaging *was* infringing. (10a.)

Orders in the Ninth Circuit

Following the aforesaid Orders, Defendant appealed. On August 18, 1995, the Court of Appeals for the Ninth Circuit affirmed the lower Courts' Orders. (1a.) On September 27, 1995, the Ninth Circuit denied Defendant's Petition for Rehearing and rejected the Suggestion for Rehearing *en Banc*. (5a.)

REASONS FOR GRANTING A WRIT OF CERTIORARI

I.

THE DECISION IN THIS CASE CANNOT BE RECONCILED WITH THE CASES FROM OTHER CIRCUITS REPRESENTING THE MAJORITY VIEW, HOLDING THAT THERE IS NO VALID CLAIM FOR INFRINGEMENT WHERE THE ALLEGED INFRINGER HAS AN INDICATION OF ORIGIN DISPLAYED PROMINENTLY AND PERMANENTLY ON THE PRODUCT OR THE PACKAGING.

This case is significant from a commercial perspective since it is necessary for manufacturers and distributors to be able to predict whether and how they can market their product without violating the Lanham Act. The problem with the decision from the Ninth Circuit is that it gives Plaintiff a virtual monopoly on decorative tins in a shrink-wrapped four-pack in a two by two format and the right to be the only cookie company in America to use Victorian tins. This decision cannot be reconciled with cases from other Circuits which hold that there can be no trade dress infringement where the name of the source is prominently and permanently displayed upon the product.

In the *Bristol-Myers* case the Court found that the District Court relied upon clearly erroneous findings of fact and abused its discretion by determining that there was a likelihood of confusion between the trade dress of two competing pharmaceutical products. The Court reversed

the District Court's determination that the defendant committed trade dress infringement, basing its reversal on an analysis using the factors enunciated in the case of *Polaroid Corp. v. Polerad Electronics Corp.*, 287 F.2d 492 (2nd Cir. 1961) *cert. denied*, 386 U.S. 820, 7 L.Ed.2d 25 (1961). See *Bristol-Myers*, 973 F.2d 1033, 1043.

It was established by the record in this case and is beyond refute that Maurice Lenell has its name on its product and packaging, and Bader's does not, although it uses the name "Baker's Estate". (TR2 pages 13-2; 26.) Despite the distinctions between the labeling of the two different brands of cookies, the District Court found there was a likelihood of confusion. Cases from other Circuits hold that despite intentional copying of trade dress, the presence of a prominent brand name displayed upon the product precluded a finding of trade dress infringement.

In the recent case of *Conopco, Inc. v. May Department Stores,* the Court reversed the District Court's decision, finding that the defendant Venture's logo was prominently placed upon bottles of lotion, that the consuming public had ample opportunity to familiarize itself with the Venture brand, and that there was no apparent confusion shown. These factors, the Court found, supported only one conclusion -- that there could be no likelihood of confusion. *Conopco,* 46 F.3d 15561, 1571-2.

In the instant case, the same factors are present. The record shows that Maurice Lenell's name was prominently displayed on the packaging and tins and nothing to show there was any confusion between the names of the different bakers. Further, since Maurice Lenell has been manufacturing shortbread cookies since the 1930's,

the consuming public has had an ample opportunity to acquaint itself with Maurice Lenell's products. (TR 89-90.) It is important to point out that Plaintiff presented no evidence whatsoever of actual or apparent confusion between the two products. Thus, under the analysis of *Conopco*, Maurice Lenell cannot be liable for trade dress infringement.

The same analysis used in the *Conopco* case is also used in Circuits other than the Ninth Circuit. In the case of *August Storck K.G. v. Nabisco, Inc.*, 55 F.3d 1300, the Seventh Circuit Court of Appeals found that a "possibility" of confusion was insufficient to support the issuance of injunction, particularly since public is benefitted by product comparison and competition. *August Storck K.G.*, 55 F.3d 1303-4. Additionally, in the case of *Versa Products Company, Inc. v. Bifold Company, Ltd.*, 50 F.3d 189 (3rd Cir. 1995), the Third Circuit found the labeling on valves used in off-shore oil drilling rigs was sufficiently different to alert an ordinary consumer that the manufacturers of the two valves were different. The Court stated, "...a plaintiff may prevail in a trade dress infringement action only if it shows that an appreciable number of ordinarily prudent consumers of the type of product in question are likely to be confused as to the source of the goods." *Versa Products*, 50 F.3d at 200, *citing Nikon, Inc. v. Ikon Corp.*, 987 F.2d 91, 94 (2nd Cir.1993); and *West Point Mfg. Co. v. Detroit Stamping Co.*, 222 F.2d 581, 589 & n. 2 (6th Cir.1955).

Further, the Court found that the record simply did not support a finding of "likelihood of confusion" where, as in this case, the products were clearly labeled with the competitor's name. The Court explained:

> Furthermore, one expects a consumer exercising ordinary care to ascertain the source of a product to rely much more on packaging, trademarks, and advertising, which if not deceptive tend to reveal the product's source unambiguously, than on the product configuration, which usually does not contain an explicit statement of the producer's identity. While it might be shown that consumers in fact rely on a particular product's configuration to identify its source, such deviation from the normal pattern (i.e., from reliance on trademarks, packaging, and advertising) would be rare. *Because clear labeling thus should generally be legally and factually sufficient to remedy confusion where unpatented product configurations are at issue, clarity of labeling (and marketing) must be taken into account in considering whether there is a likelihood that consumers exercising ordinary care will be confused as to the sources of substantially identical products.* [emphasis added]

Versa Products Company, Inc. v. Bifold Company, Ltd., 50 F.3d 189, 203.

By contrast, in the instant case, both the District Court and the Ninth Circuit concluded that since consumers do not engage in "lengthy consideration or comparison shopping", before buying cookies, the differences between the packages, including the differing brand names, were of no import. (R 32, also see 3a.) This represents a minority view of the significance of differing brand names upon a product. This Court must also consider that the uncertainty created by the Ninth Circuit's position could delay or halt the introduction of competing products on a nationwide basis

and give an undue advantage to products produced in the portion of the United States comprising the Ninth Circuit. Further, such a variation in the application of the Lanham Act between the several Circuits encourages forum-shopping for plaintiffs wishing to destroy their competitors through litigation, rather than by means of fair competition.

Other cases support Defendant's position that clear labeling of products should preclude a finding of trade dress infringement. See *Merriam-Webster, Inc. v. Random House, Inc.*, 35 F.3d 65, 71 (Court reversed District Court where clearly labeled dictionaries of rival companies precluded possibility of confusion.); *accord*, *Venn v. Goedert*, 319 F.2d 812, 816 (8th Cir. 1963) (Clear labels on packages of similar soft cookies prevented finding of unfair competition.)

Additionally, the Court's opinion in the case of *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, supports Defendant's position that a reversal of the Order granting a preliminary injunction is warranted under the facts of this case. See *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033. In the *Bristol Myers* case, the Second Circuit Court of Appeals reversed an injunction even though it found that the District Court did not clearly err when it concluded that the plaintiff's trade dress had secondary meaning and that the defendant's imitation of that trade dress was intentional. *Bristol-Myers Squibb Co.*, 973 F.2d at 1043.

Although the Court of Appeals found the District Court to be correct in its assessment of nearly every factual issue, it concluded that the District Court should have found there was no likelihood of confusion based upon the fact that both products clearly set forth the names, "Excedrin",

and "Tylenol", and thus, the source was prominent and the two products were not likely to be confused. See *Bristol-Myers*, 973 F.2d 1033, 1046-7.

In the instant case, both parties had clear labeling visible at the point of purchase and affixed permanently to the tins. This should have been enough to avoid confusion even for an unsophisticated consumer. Also, since both names are displayed, it is significant that both Plaintiff's brand name and Defendant's names are sufficiently different and well-known to forestall any confusion on the part of the consumers. In this case as in the *Bristol-Myers* case, this factor precludes the likelihood of confusion. Also, Plaintiff failed to show with any survey results or other evidence that there existed any actual confusion, and offered no evidence whatsoever of any likelihood of confusion. Further, this case is a stronger case in favor of Defendant than the *Bristol-Myers* since not only are the colors and images used in the packaging different, but the sizes of the tins are different as well. Moreover, Defendant Maurice Lenell used winter scenes in its Motion for Approval of Redesigned Packaging, and the Court found that Maurice Lenell's artwork did not violate Bader's trade dress, although it found the four-pack packaging to be violative.

Another instructive case on this issue is the case of *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1131, in which were involved manufacturers of two different lines of athletic shoes, the plaintiff's being the higher priced line of running shoes. The Court of Appeals reversed the District Court's finding that the defendant had violated the Lanham Act by copying the plaintiff's trade dress. The Court based its reasoning on the cases of *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 84 S.Ct. 784, 11 L.Ed.2d 661 (1964) and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 84

S.Ct. 779, 11 L.Ed.2d 669 (1964), *rehearing denied* 377 U.S. 913, 84 S.Ct. 1162, 12 L.Ed.2d 183 (1964), in which this Court established that the public has the right to copy unpatented and uncopyrighted designs so long as there is no likelihood of confusion. See *L.A. Gear*, *Id.*, 988 F.2d 1117, 1131-2.

Additionally, another factor in the *L.A. Gear* case which was found to minimize confusion was the fact that the two lines of shoes were sold in different kinds of stores. See *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 967 (2nd Cir. 1981) (Fact that plaintiff's product only sold in specialty stores was sufficient to sustain finding of no confusion.). Also, since the brand labeling was permanent and not meant to be removed, there was less chance of confusion after the purchase. *L.A. Gear*, 988 F.2d 1117, 1134. In this case as in *L.A. Gear*, both packages had the name of the source prominently and permanently displayed.

In the instant case, the evidence at both hearings demonstrated that the artwork used by Bader's was not copyrighted, and of course, not patented. It was also shown that Bader's was a mere licensee of the images it used on its Christmas tins. Similarly to the *L.A. Gear* case, Defendant's cookies in their four-pack configuration, were to be sold at one store, the Sam's Club Warehouse Stores, discount stores which do not sell Plaintiff's cookies. This was found to prevent product confusion in several cases, including the *L.A. Gear* case. See *L.A. Gear*, 988 F.2d 1117, 113. Moreover, the type of store selling the product can be significant. As the *L.A. Gear* Court noted, discount store customers (such as the consumers shopping at Sam's Warehouse) are sufficiently sophisticated to distinguish between two competitor's products. Had this case been decided under the prevailing majority view as enunciated in *Conopco*, *August Storck*, *Merriam-Webster*, *Versa Products*, *L.A. Gear*, and *Bristol-Myers*, Plaintiff is certain

the outcome would have been quite different. The Lanham Act must be applied uniformly throughout the Circuits. Therefore this Court should grant the instant Petition.

II.

THE RECORD SHOWS THAT THE REDESIGNED PACKAGING DID *NOT* FEATURE A VICTORIAN CHRISTMAS SCENE AND FEATURED THE WORK OF DIFFERENT ARTISTS USING WINTER SCENES; ACCORDINGLY, THE ONLY FEATURES IN COMMON WITH PLAINTIFF'S PRODUCT WAS THE REQUIRED FUNCTIONAL TWO-BY-TWO SHRINK-WRAPPED, FOUR-PACK FORMAT AND THE CARDBOARD SURROUND.

Although the Ninth Circuit Court of Appeals found that the record supported the District Court's conclusion, at the hearing before Judge Rothstein on October 7, Terry Cohen's testimony established that the artwork on Maurice Lenell's tins had been replaced with four "stock", winter scene designs. Cohen testified that two of the stock designs were ones that Maurice Lenell used in the past and all were designs which featured winter scenes with no Christmas or Victorian orientation. (TR2 pages 7-13.)

The record also shows that the cardboard surround and packaging configuration was functional in nature. It is well established that a functional component of packaging is not entitled to trade dress protection. *Aromatique v. Gold Seal, Inc.*, 28 F.3d 863, 868 (8th Cir. 1994).

At the hearing of October 7, 1994, Maurice Lenell's executive, Terry Cohen, explained that the cardboard container that housed the cookie tins was required by Sam's Warehouse because the four-pack is sold on pallets which require the decorative tins to be viewed by the public with a shrink-wrap to hold the packages together. In addition, the testimony established that the cardboard packaging was used both for shipping, handling, and to provide an area for "shelf talk". Significantly, there is nothing on the record to contradict this testimony. (TR2 10-13.)

Richard Papera, the vice-president of Allstate Can Company, also testified that the cans he manufactured (for the redesigned packaging), were designed with stock artwork provided by his company. He described the differences between the redesigned tins and the Bader's tins. Defendant's attorney also filed a signed declaration by the witness. Mr. Papera testified that Aparco foods, a cookie company, used a four-pack in a size similar to Maurice Lenell's several years before, and had used Christmas designs. He stated that there were also other food companies that used the same tins. Thus, the record establishes that there were other cookie companies with the same type of packaging and similarly-sized cans. Although there was also no evidence in the record contradicting the testimony of this independent witness, this Court disregarded this uncontested evidence in favor of an unsupported conclusion that Plaintiff's trade dress is "unique". (TR2 pages 33-47.)

The Ninth Circuit, after giving due deference to the District Court's assessment and weighing of the evidence should nevertheless have been ..."left with a definite and firm conviction that a mistake has been committed," *Versa Products Company, Inc. v. Bifold Company, Ltd.*, 50 F.3d

189, 200 (3rd Cir. 1995) *citing Anderson v. Bessemer City*, 470 U.S. 564, 573, 105 S.Ct. 1504, 1511, 84 L.Ed.2d 518 (1985); also see *Venn v. Goedert*, 319 F.2d 812, 816 *supra*. (Court found that although the cookies produced by each party were the same, inclusion of the defendant's name clearly upon the labeling used in a cookie package prevented conclusion of unfair competition.); The result in this case should be the same as in the *Venn* case.

In the hearing before Judge Rothstein, it became apparent that Bader's true goal was to prohibit every other cookie producer from selling a four-pack of tinned cookies. The Ninth Circuit Court appeared to approve of this goal in its Decision. (See 2a-3a.) However, Bader's cannot protect a method of doing business. In the case of *Aromatique v. Gold Seal, Inc.*, 28 F.3d 863, the Court stated:

> Trade dress is the "total image of a product, the overall impression created, not the individual features." *Woodsmith Publishing Co. v. Meredith Corp.*, 904 F.2d 1244, 1247 (8th Cir.1990). But the mere method and style of doing business is not protectable. *Prufrock Ltd. v. Lasater*, 781 F.2d 129, 131-32 (8th Cir.1986). *Indeed, " '[i]t would be ludicrous ... to suggest that in our free enterprise system, one producer and not another is permitted to take advantage of [a] marketing approach to enhance consumer reception of its product.' " Prufrock, supra*, 781 F.2d at 132 (quoting *Haagen-Dazs, Inc. v. Frusen Gladje, Ltd.*, 493 F.Supp. 73, 75 (S.D.N.Y.1980)). *Trade dress does not protect one from a competitor's imitation of one's marketing concept. Prufrock, supra*, 781 F.2d

at 132. [emphasis added]

See *Aromatique v. Gold Seal, Inc.*, 28 F.3d 863, 868.

In this case, Plaintiff seeks to hold a virtual monopoly on the sale of a four-pack of tinned cookies. However, the sale of four tins rather than two or three and the capacity of the tins is nothing more than a marketing concept and cannot be protected by the Lanham Act. Since the District Court's Order as it stands can be interpreted in several different ways, Bader's argues that it is now in a position to hold a virtually exclusive right to sell tinned cookies in a decorative, four-pack format of two tins side by side. This exclusive right would not exist in other Circuits, and is neither fair or just. Further, since the Order of September 2, as it now stands is both vague and broad, Bader's interpretation of this Order has been given free reign and Bader's has attempted to drive Maurice Lenell out of business through litigation rather than by the means of fair competition.

In addition, the Order of September 2, restrains Defendant Maurice Lenell from producing Easter tins which were not even introduced at the evidentiary hearing. This is a case of national significance as a result of the Ninth Circuit Affirmance of a District Court's ruling allowing a local cookie company in Seattle to be the only cookie company in the United States that is permitted to market cookies in a four-pack of decorative tins in a two-by-two configuration. Justice requires this Court to grant Defendant's Petition. Therefore, this Court should grant Defendant Maurice Lenell's Petition for a Writ of Certiorari.

SUMMARY OF ARGUMENTS

In summary, the Ninth Circuit Court of Appeals should have followed the other Circuits on this issue and concluded that the presence of Defendant's name permanently and prominently displayed upon the product, both on the tins and on the packaging, precluded a conclusion that there was a likelihood of confusion between Plaintiff's product and Defendant's product. Further, the later finding of infringement was unsupported by the record which showed that Defendant had redesigned the artwork upon its containers and the only common elements of the products were functional in the use of its packaging.

CONCLUSION

For the reasons set forth herein, Defendant-Petitioner, HEARTHSIDE BAKING COMPANY d/b/a MAURICE LENELL COOKING COMPANY, respectfully requests this Court to grant its Petition for Certiorari and to summarily reverse the Decision of the Ninth Circuit Court of Appeals entered on August 18, 1995, and to summarily reverse the District Court's Orders of September 2, September 9, October 7, and October 11, 1994. Alternatively, Defendant-Petitioner requests that this case be set for plenary consideration.

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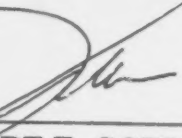
Respectfully submitted,
Defendant - Petitioner,
HEARTHSIDE BAKING
COMPANY, d/b/a MAURICE
LENELL COOKING COMPANY,

By:



ROBERT E. GORDON

APPENDIX

NOT FOR PUBLICATION

UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

BADER'S DUTCH BISCUIT CO., INC, a Washington corporation,	)	
Plaintiff-Appellee,	)	C.A. No. 94-36048
v.	)	D.C. No. CV-94-00726
HEARTHSIDE BAKING CO., INC., doing business as MAURICE LENELL COOKING COMPANY, an Illinois corporation,	)	**MEMORANDUM***
Defendant-Appellant.	)	

Appeal from the United States District Court for the Western District of Washington Walter T. McGovern & Barbara Rothstein, District Judges, Presiding

Argued and Submitted July 19, 1995
Seattle, Washington

Before: FARRIS, NOONAN, and HAWKINS, Circuit Judges.

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* This disposition is not appropriate for publication and may not be cited to or by the courts of this circuit except as provided by 9th Cir. R. 36-3.

I.

We review a district court's grant of a preliminary injunction for abuse of discretion. *Miller v. California Pacific Medical Center*, 19 F.3d 449, 455 (9th Cir. 1994) (en banc). Bader's Dutch Biscuit can protect its trade dress if it is nonfunctional, inherently distinctive, and the infringing product is confusingly similar. *International Jensen v. Metrosound U.S.A.*, 4 F.3d 819, 823 (9th Cir. 1993).

Hearthside argues that the district court committed a manifest error because Bader's Dutch Biscuit allegedly had not presented any evidence that the packaging is nonfunctional. We reject the argument. Bader's Dutch Biscuit was the first company to sell cookies in a four pack of tins. Further, "for the last two years, [Bader's Dutch Biscuit] had to work to convince the stores that particular pack would sell." The record indicates that Sam's wanted a particular quantity of cookies to reach a "selling price." It does not demonstrate, however, that the four pack in this can size was a functional requirement. nor does the record show that other stores require this four pack arrangement.

Second, Hearthside asserts that Bader's Dutch Biscuit's packaging is not inherently distinctive. Hearthside introduced evidence of other snack food companies that use either Victorian art, similar sized cans, or multiple product packages. The district court concluded that "no other cookie company sells cookies in tins of the size and configuration used by Bader's which are also decorated with Victorian art." This finding was not clearly erroneous. *Miller*, at 455 (reviewing for clearly erroneous findings of fact).

Finally, Hearthside argues that there is no likelihood of confusion. The district court considered the seven factors listed in *Eclipse Assoc. Ltd. v. Data General Corp.*, 894 F.2d 114, 117-8 (9th Cir. 1990). It found Bader's Dutch Biscuit's trade dress strong because its sales had increased dramatically and no other cookie manufacturer had a similar trade dress. It found that Hearthside's packaging is similar. Although a careful side-by-side comparison of Bader's Dutch Biscuit's trade dress reveals some slight differences, "the overall format of the designs is so similar that the differences are subsumed in the general similarity of appearance." The district court correctly concluded that cookie purchases are a "casual decision not involving lengthy consideration or comparison shopping." The companies are selling exactly the same type of shortbread cookies. The companies are seeking to sell their cookies through the same types of retail outlets, such as supermarkets, drug stores, and discount warehouses. Finally, the district court found evidence of Hearthside's intent to adopt the trade dress. There is no abuse of discretion.

II.

Hearthside argues that the district court erroneously set a bond of only $10,000. It had requested a bond of $7 million, the value of its 700,000 tins affected by the preliminary injunction. The district court did not abuse its discretion. Hearthside ordered production and distribution of its 700,000 tins after Bader's Dutch Biscuit moved for a preliminary injunction. Instead of running the risk of an injunction, Hearthside could ordered tins with a different trade dress. The $10,000 bond covers all Hearthside's expenses incurred before Bader's Dutch Biscuit filed this action.

III.

Hearthside made slight modifications to its tin

artwork in an attempt to avoid trade dress infringement. The district court concluded that "[Bader's Dutch Biscuit] still has strong probability of success on the merits of its claim that [Hearthside's] trade dress as redesigned still infringes on [Bader's Dutch Biscuit's] trade dress." The district court did not abuse its discretion. The new artwork depicts one continuous Victorian scene. The size and shape of its tins did not change. It is using a four-pack configuration in the same cardboard container. The likelihood of confusion has not been eliminated.

AFFIRMED.

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

BADERS DUTCH BISCUIT CO., INC., a Washington corporation corporation,	)	
Plaintiff,	)	
v.	)	C.A. No. 94-36048
HEARTHSIDE BAKING CO., INC., d/b/a MAURICE LENELL COOKING COMPANY, an Illinois corporation, NATIONWIDE MARKETING, INC., a Texas s corporation, and BILL BAILEY, an individual,	)	D.C. No. CV-94-00726
Defendants.	)	

BEFORE: FARRIS, NOONAN and HAWKINS, Circuit Judges.

The panel has voted to deny appellant's petition for rehearing. Judges Noonan and Hawkins have voted to reject the suggestion for rehearing en banc, and Judge Farris so recommends.

The full court has been advised the suggestion for rehearing en banc and no active judge has requested a vote on wether to rehear the matter en banc. Fed. R. App. P. 35.

The petition for rehearing is denied and the suggestion for rehearing en banc is rejected.

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

BADERS DUTCH BISCUIT CO., INC., a Washington corporation, Plaintiff, v. HEARTHSIDE BAKING CO., INC., d/b/a MAURICE LENELL COOKING COMPANY, an Illinois corporation, NATIONWIDE MARKETING, INC., a Texas corporation, and BILL BAILEY, an individual, Defendants.	NO. C94-726R ORDER DENYING DEFENDANT'S MOTION TO RECONSIDER PRELIMINARY INJUNCTION ORDER, SETTING BOND AND GRANTING PLAINTIFF'S MOTION TO COMPEL COMPLIANCE WITH PRELIMINARY INJUNCTION

THIS MATTER comes before the court on a motion by defendant Hearthside Baking Co. d/b/a Maurice Lenell Cooking Company ("Maurice Lenell") to reconsider the court's preliminary injunction orders of September 2 and September 9, 1994 and to set bond, and on a motion by plaintiff Baders Dutch Biscuit Co., Inc. ("Baders") to compel compliance with the court's preliminary injunction order of September 2, 1994. Having reviewed the motions together with all documents filed in support and in opposition, and being fully advised, the court finds

and rules as follows:

1. *Motion to Reconsider Preliminary Injunction*

Maurice Lenell asks the court to reconsider its preliminary injunction orders entered on September 2 and September 9, 1994. Most of Maurice Lenell's arguments simply repeat contentions raised in its prior briefs and at the preliminary injunction hearing held on August 30, 1994. The court has already considered those argu[-]ments and rejected them.

Maurice Lenell does raise one new argument concerning the defense of aesthetic functionality. CR 7(e)(1), Local Rules W.D. Wash., provides that the court will ordinarily deny motions for reconsideration raising new arguments in the absence of a showing of manifest error in the prior ruling or a showing of new facts or authority which could not have been brought to the court's atten[-]tion earlier with reasonable diligence. In this case, Maurice Lenell has met neither standard. The court accordingly sees no reason to grant reconsideration based on the defense of aesthetic functionality.

2. *Motion to Set Bond*

Fed. R. Civ. P. 65(c) requires the court to consider the issue of a bond to accompany the injunction "in such sum as the court deems proper, for the payment of such costs and damages I as may be incurred or suffered by any party who is found to have been wrong[-]fully enjoined or restrained."

Maurice Lenell argues that a bond of $10,000,000 is appropriate based on the projected losses resulting from its inability to sell
the enjoined cookie tins. Baders responds that a $10,000 bond is sufficient because that was the total amount

expended by Maurice Lenell on the enjoined cookie tins prior to Baders' initiation of this lawsuit.

The court concludes that, given the equities in this case, Baders is correct. Before Baders filed suit, Maurice Lenell had spent $10,000 to purchase the designs later used on the enjoined cookie tins. Only after it received notice of Baders' contention that the tins infringed on Baders' distinctive trade dress did Maurice Lenell incur significant expenses to have the tins made and distributed. Thus Maurice Lenell decided to order production and distribution of the tins with full knowledge that it ran the risk of being enjoined. Under these circumstances, the court will exercise its discretion to require Baders to post a $10,000 bond. *Cf., Budish v. Gordon*, 784 F. Supp. 1320, 1338 (N.D. Ohio, 1992). Baders' request that the court require Maurice Lenell to post a bond is denied.

3. *Motion to Compel Compliance with Preliminary Injunction*

Baders moves for an order compelling compliance with the provi[-]sion of the preliminary injunction entered on September 2, 1994 which requires Maurice Lenell to produce a list of people and companies from which defendant has solicited orders by displaying the offending trade dress. Baders' motion is granted. Maurice Lenell shall provide Baders with the list within five days of the date of issuance of this order.

For the above-stated reasons, Maurice Lenell's motion for reconsideration is DENIED, its motion for an order requiring Baders to post bond is GRANTED in the amount of $10,000, and Baders' motion to compel compliance with the preliminary injunction is GRANTED.

DATED at Seattle, Washington this 7th day of October, 1994.

WALTER T. McGOVERN
UNITED STATES DISTRICT JUDGE

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

BADERS DUTCH BISCUIT CO., INC., a Washington corporation,	)	
Plaintiff,	)	NO. C94-726R
v.	)	ORDER DENYING DEFENDANT'S MOTION FOR APPROVAL OF REDESIGNED COOKIE TINS
HEARTHSIDE BAKING CO., INC., d/b/a MAURICE LENELL COOKING COMPANY, an Illinois corporation, NATIONWIDE MARKETING, INC., a Texas corporation, and BILL BAILEY, an individual,	)	
Defendants.	)	

THIS MATTER comes before the court on a motion by defendant Hearthside Baking Co., Inc. d/b/a Maurice Lenell Cooking Company for approval of redesigned cookie tins. Recognizing the urgent need for a decision so as to enable defendant to meet its dead[-]lines, the court is issuing this abbreviated ruling based on the testimony and exhibits introduced in court earlier this

day as well as the entire record in this case.

The issue before the court is straightforward: Does defendant's shrinkwrapped 4-pack of shortbread cookies with redesigned cookie tins still infringe on plaintiff's trade dress? In an earlier order granting a preliminary injunction, Judge Walter T. McGovern ruled that plaintiff had established a strong probability of success on the merits of its claim that defendant's trade dress was so similar to the distinctive trade dress adopted by plaintiff that it was likely to cause confusion in the marketplace. *See* Judge McGovern's orders of September 2 and September 9, 1994 in this case.

Since that time, defendant has redesigned the artwork on the tins in which the cookies are sold. However, defendant is still using the same shrinkwrapped 4-pack configuration in the same cardboard container. Moreover, the tins are still so close in size and shape to plaintiff's tins as to appear virtually the same to the untrained eye. When these similarities are considered in conjunction with the essential similarity in theme among plain-tiff's and defendant's cans, i.e. Victorian art depicting scenes and figures appropriate to the holiday season, the court concludes that plaintiff still has a strong probability of success on the merits of its claim that defendant's trade dress as redesigned still infringes on plaintiff's trade dress.

The court recognizes that defendant has selected artwork which avoids Christmas images and has concentrated on winter scenes, and that the redesigned tins use images that were not created by the same graphic artist who designed plaintiff's tins. Therefore, it appears to the court that were defendant to combine the redesigned tins with a reconfiguration of the packaging, plaintiff's concern about infringement or trade dress might

be met. Given the urgency of defendant's schedule, the court strongly urges counsel and the parties to meet immediately and confer about a reconfigured format for distributing defendant's product in the redesigned tins.

Defendant's motion for approval of the redesigned tins is accordingly DENIED.

DATED at Seattle, Washington this 7th day of October, 1994.

BARBARA J. ROTHSTEIN
UNITED STATES DISTRICT JUDGE

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

BADERS DUTCH BISCUIT CO., INC., a Washington corporation,	)	
Plaintiff,	)	NO. C94-726R
v.	)	ORDER GRANTING PLAINTIFF'S MOTION FOR PRELIMINARY INJUNCTION
HEARTHSIDE BAKING CO., INC., d/b/a MAURICE LENELL COOKING COMPANY, an Illinois corporation, NATIONWIDE MARKETING, INC., a Texas corporation, and BILL BAILEY, an individual,	)	
Defendants.	)	

THIS MATTER comes before the court on a motion by plaintiff Bader's Dutch Biscuit Co., Inc., d/b/a Maurice Lenell Cooking Company, Nationwide Marketing, Inc. and Bill Bailey. [1] Having reviewed the motion together with all documents filed in support and in opposition, having held an evidentiary hearing and being fully advised, the

[1] Defendants Nationwide Marketing, Inc. and Bill Bailey have not submitted any opposition to plaintiff's motion nor have they filed an answer to plaintiff's complaint. Plaintiff's motion for injunctive relief against them is granted as unopposed.

court finds and rules as follows:

I. FACTUAL BACKGROUND

Bader's Dutch Biscuit Co., Inc. ("Bader's") owns and operates a commercial, wholesale bakery in Seattle, Washington. It is undisputed that, since 1991, Bader's has sold over 2.2 million tins decorated with Victorian art and containing Bader's shortbread cookies. Bader's contends that these decorative tins constitute a distinctive trade dress for its cookies which is widely recognized and accepted by the public.

Bader's complaint in this case alleges that defendant Hearthside Baking Co., Inc. d/b/a Maurice Lenell Cooking Company ("Maurice Lenell") has also developed a line of cookie tins decorated with Victorian art to serve as packaging for Maurice Lenell's shortbread cookies. Bader's further alleges that Maurice Lenell's decorative tins are so similar in appearance to those sold by Bader's that the infringe on Bader's trade dress in violation of both federal and Washington state common law. Bader's accordingly moves for a preliminary injunction barring Maurice Lenell from using the alleged infringing trade dress.

II. LEGAL ANALYSIS

A. *Standard for Preliminary Injunction*

In order to establish that preliminary injunctive relief is warranted, the moving party has the burden of showing either: (1) a likelihood of success on the merits, and the possibility of irreparable injury; or (2) the existence of serious questions going to the merits and the balance of hardships tipping in favor of the moving party.

Apple Computer, Inc. v. Formula International, Inc., 725 F.2d 521, 523 (9th Cir. 1984).

B. *Likelihood of Success on the Merits*

Bader's states a claim for trade dress infringement under § 43 (a) of the Lanham Act, 15 U.S.C. § 1125(a), which prohibits use of a "false designation of origin." In order to establish trade dress infringement, Bader's must show that the trade dress adopted by Maurice Lenell is so similar to Bader's trade dress that it is likely to cause confusion in the consumer about the origin or source of the product. *Two Pesos, Inc. v. Taco Cabana, Inc.*, ___ U.S. ___, 112 S.Ct. 2753, 2758 (1992).[2]

The parties agree that it is appropriate to consider the follow[-]ing factors in determining whether the likelihood of confusion exists in this case: 1) the strength of Bader's trade dress; 2) the degree of similarity between Bader's and Maurice Lenell's trade dresses; (3) the degree of care likely to be exercised by consumers; (4) the similarity of the products being sold; (5) the area and manner of concurrent use; and (6) Maurice Lenell's intent in adopting its trade dress.[3] *Cf., International Kennel Club of Chicago, Inc. v. Mighty Star Inc.*, 846 F.2d 1079, 1087(7th Cir. 1988), *citing Polaroid Corp. v. Polared Electronics*

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[2] In order to qualify for protection under § 43(a) of the Lanham Act, the features of the trade dress at issue must also be nonfunctional. *Two Pesos, Inc. v. Taco Cabana, Inc.*, ___ U.S. ___, 112 S.Ct. 2753, 2758 (1992). The court need not address this question because Maurice Lenell does not contend that the contested features are functional.

[3] Maurice Lenell also mentions as additional factors the identity of advertising media used and the evidence of actual confusion. There was some testimony elicited at the preliminary injunction hearing about Bader's advertising, but none concerning Maurice Lenell's advertising. The court has insufficient informa-tion to explore this factor. Likewise, there was no testimony presented regarding instances of actual confusion.

Corp., 287 F.2d 492, 495 (2d Cir.), *cert. denied*, 386 U.S. 820 (1961).

Before applying these factors to the facts of this case, the court notes that the general use of Victorian art in packaging is not at issue. Bader's does not dispute that Victorian art is in the public domain or that Maurice Lenell has the right to sell its cookies in tins decorated with Victorian artwork. The gravamen of Bader's case is more narrowly focused on the contention that, in violation of the laws against trade dress infringement, Maurice Lenell has virtually duplicated Bader's distinctive trade dress.

1. *The strength of Bader's trade dress.* As stated above, Bader's contends and Maurice Lenell does not dispute that Bader's has sold more than 2.2 million cookie tins with the trade dress at issue here. Moreover, according to the evidence before the court at this time, no other cookie company sells cookies in tins of the size and configuration used by Bader's which are also decorated with Victorian art. To that extent, Bader's trade dress is inher-ently distinctive and unique.[4]

2. *Degree of similarity between the trade dresses.* Having carefully compared Bader's and Maurice Lenell's cookie tins, the court finds that Maurice Lenell's tins are extremely similar in appearance to Bader's tins. They are the same shape as well as virtually the same size,[5]

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[4] For this reason, the court finds it unnecessary to consider whether Bader's trade dress has acquired secondary meaning. In *Two Pesos, Inc. v. Taco Cabana, Inc.*, ___ U.S. ___, 112 S.Ct. 2753 (1992), the United States Supreme Court held that proof of second-ary meaning is not required to prevail on a claim under § 43(a) of the Lanham Act where the trade dress at issue is inherently dis-tinctive.

[5] According to the testimony of Terry Cohen, Maurice Lenell's chief executive officer, Maurice Lenell's tins are 1/4" taller and 1/4" narrower in diameter than Bader's tins. This difference is so small as to be unnoticeable except on a close side-by-side compari-son.

contain the same shortbread cookie, and are packaged in the same shrink-wrapped four-pack configuration. As for the Victorian art decorating the tins, Maurice Lenell has adopted the same format used on Bader's tins, namely three large vignettes around the tin with smaller vignettes printed between the large ones. The large vignettes are surrounded by a decorative border and written messages are featured at the bottom of the smaller vignettes. While the specific images contained in the vignettes are not the same, the general style of the images is very similar.[6]

At the preliminary injunction hearing, Maurice Lenell elicited testimony from Ray Braun, the graphic artist who created the designs for both Bader's and Maurice Lenell, concerning the differ[-]ences between the two sets of designs. According to his testimony, the differences include the use of pastel colors in Maurice Lenell's designs as compared to more primary colors on Bader's tins, different patterns in the borders around the vignettes, white spots on the background of the Maurice Lenell tins as compared to a solid background on Bader's tins, and the use of a greater number of small images on Bader's tins. in addition, the tops of the tops of the tins differ in appearance.

A side by side comparison of the two sets of tins does reveal differences in the designs. However, the overall format of the designs is so similar that the differences are subsumed in the general similarity of appearance. In other words, the differences, which are for the most part subtle, are overshadowed by the simi[-]larities in the designs. This is particularly true because

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[6] The similarity may be attributable to the fact that, in developing the designs at issue, Maurice Lenell employed the services of the same graphic artist who had previously assisted Bader's in designing its decorated cookie tins.

of the nature of the packaging used. The cardboard container in which the shrink wrapped four-pack is seated conceals the bottom portion of the tins. This configuration accentuates the strong similarities in the vignette formats used in both sets of designs.

3. *The degree of care likely to be exercised by consumers.*

Bader's contends and Maurice Lenell does not dispute that even when sold in a four-pack, the cookies retail for approximately $10.00. Thus, purchase of the cookies by the average consumer would probably be a casual decision not involving lengthy consider[-]ation or comparison shopping.

4. *The similarity of the products being sold.*

There is no dispute that Maurice Lenell and Bader's are both selling exactly the same type of shortbread cookies in the tins at issue.

5. *The area and manner of concurrent use.*

While the evidence on this point is not complete, the testimony before the court to date indicates that both Bader's and Maurice Lenell seek to sell their cookies through the same types of out[-]lets, including supermarkets, drug stores and discount warehouses.

6. *Maurice Lenell's intent in adopting trade dress.*

Maurice Lenell's chief executive officer, Terry Cohen, testified at the preliminary injunction hearing that Maurice Lenell did not intend to copy Bader's trade dress, but simply to create its own cookie tin designs using Victorian art. Whatever Maurice Lenell's subjective intent may have been, the fact remains that it hired the same graphic artist previously employed by Bader's and that the format of the Victorian art designs created by

that graphic artist for Maurice Lenell bears a striking resemblance to the format appearing on Bader's tins.

During the hearing, Maurice Lenell sought to demonstrate that Victorian art is not only in the public domain, but that it is very commonly used in the trade dress of numerous products, including many sold in tins. The court finds it significant that not one single Victorian art design brought to the court's attention at the hearing other than the set of Maurice Lenell designs bore a signif[-]icant resemblance to the Bader designs.

The remarkable similarity between the formats of the designs at issue in this case, coupled with the similarities in size, configu[-]ration, packaging and product sold are strong evidence tending establish Maurice Lenell's awareness of and intent to model its trade dress on Bader's designs.

Based on its examination of the six factors discussed above, the court concludes that Bader's has established a strong probability of success on the merits of its claim that Maurice Lenell's trade dress is so similar to that of Bader's that it is likely to cause confusion in the marketplace.

C. *Irreparable Injury*

Once the plaintiff in an infringement action has established a likelihood of confusion, it is ordinarily presumed that the plain[-]tiff will suffer irreparable injury if injunctive relief does not issue. *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 1220 (9th Cir. 1987); *Apple Computer, Inc. v. Formula International, Inc.*, 725 F.2d 521, 526 (9th Cir. 1984). Given the court's finding that Bader's has shown a likelihood of success on the merits of its trade dress infringement claim, the court presumes that Bader's will suffer irreparable harm if Maurice Lenell is not preliminarily enjoined from using a confusingly similar trade dress.

Maurice Lenell in turn contends that it will suffer irreparable injury if Bader's request for injunctive relief is granted because 24 Maurice Lenell has spent over $700,000 for cookie tins bearing the 25 contested designs. Maurice Lenell contends that it was forced to 26 order its tins in July for the coming Christmas season.

The court concludes that any injury suffered by Maurice Lenell was self-imposed. Bader's motion for preliminary injunction was filed on May 12, 19@4, well before Maurice Lenell placed its order. Instead of responding to the merits of the motion immediately, Maurice Lenell chose to contest the issues of personal jurisdiction and venue. In doing so, Maurice Lenell specifically requested that the court stay any further briefing on and consideration of Bader's motion for preliminary injunction until after Maurice Lenell's jurisdictional and venue arguments had been decided. The resulting delay in reaching the substantive trade dress issue raised by plaintiff's motion was the direct consequence of Maurice Lenell's own tactical decision to litigate jurisdictional and venue ques[-]tions first.

III. CONCLUSION

For the reasons discussed above, the court concludes that plaintiff has shown a strong probability of success on the merits of its contention that Maurice Lenell infringed upon Bader's distinctive trade dress exemplified by the cookie tins decorated with Victorian art in which Bader's packages its shortbread cookies. The court also finds that Bader's will suffer irreparable injury if the injunctive relief sought by Bader's does not issue.

The court accordingly preliminarily enjoins Maurice Lenell from infringing on Bader's trade dress. For the specific terms of the preliminary injunction, the

parties shall consult the Order issued by this court on Friday, September 2, 1994.

Finally, in keeping.with the requirements of Fed. R. Civ. P. 65(c), the court requests briefing from the parties concerning the necessity for a bond. Maurice Lenell shall submit a memorandum on or before Monday, September 12, 1994, and plaintiff shall respond by Wednesday, September 14, 1994.

DATED at Seattle, Washington this 9th day of September, 1994.

WALTER T. McGOVERN
UNITEDSTATES DISTRICT JUDGE
Honorable Barbara J. Rothstein

UNITED STATES DISTRICT
COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

BADERS DUTCH BISCUIT CO., INC., a Washington corporation,	)	
Plaintiff,	)	NO. C94-726R
v.	)	PRELIMINARY INJUNCTION
HEARTHSIDE BAKING CO., INC., d/b/a MAURICE LENELL COOKING COMPANY, an Illinois corporation, NATIONWIDE MARKETING, INC., a Texas corporation, and BILL BAILEY, an individual,	)	
Defendants.	)	

The Court, having considered the evidence presented and the arguments of counsel, hereby finds and orders as follows:

FINDINGS

1. Baders Dutch Biscuit Co., Inc., (hereinafter "Baders") has adopted a trade dress exemplified by the photograph attached hereto as Exhibit A, which is inherently distinctive and which serves to identify Baders

as the source of cookies packaged in this trade dress.

2. Defendant Hearthside Baking Co., Inc., (hereinafter "Maurice Lenell") has adopted a trade dress that is confusingly similar to the trade dress shown in the attached Exhibit A and has used the confusingly similar trade dress to solicit the sale of cookies.

3. Baders has demonstrated that it is likely to prevail in the merits of its claim that the activities of Maurice Lenell and Defendants Nationwide Marketing, Inc., and Bill Bailey constitute trademark infringement, false designation of origin in violation of Section 43(a) of the Lanham Act, trade dress infringement, and violations of the Washington State Consumer Protection Act, R.C.W. 19.86.010 et seq.

4. Baders is likely to suffer irreparable injury to its reputation and goodwill associated with its distinctive trade dress if Defendants are not enjoined from further infringing activity during the pendency of this action.

ORDER

5. Defendants and their officers, agents, affiliates, employees, representatives, and all those acting in concert or participating with them, are preliminarily enjoined from directly or indirectly engaging in or performing any and all of the following acts:

(a) using or displaying Baders' distinctive trade dress or any trade dress, service mark or trademark confusingly similar to Baders' trade dress in connection with the advertising, marketing or sale of any food, food product or the provision of any food related services;

[McG](b) ~~performing any act or using or displaying any words, names, styles, titles, symbols or marks which are likely to cause confusion, to cause mistake, or to deceive, or to otherwise mislead the trade or the public into~~

~~believing that Defendants and Baders are one and the same, or are in some way connected, or that Baders is a sponsor of Defendants or their products, or that Defendants are in some way affiliated with, associated with, or under the supervision and control of Baders, or that the products of Defendants originate or are approved of by Baders, or engaging in any activity that is likely in any way to lead the trade or the public to associate Defendants with Baders,~~ **[McG]**

(c) ~~using or displaying any words, names, titles, styles or marks which create a likelihood of injury to the business reputation of Baders or likelihood of misappropriation of Baders' distinctive trade dress and the goodwill associated therewith, and~~

(d) reproducing or distributing any copy of Baders' trade dress.

6. Defendants are further enjoined from completing any sale that was obtained by showing to the purchaser a trade dress that is confusingly similar to Baders' distinctive trade dress. Defendants are further ordered to promptly disclose to Baders the identity of all people and companies from whom orders were solicited by displaying a trade dress that is confusingly similar to Baders' distinctive trade dress. The Court specifically finds that all of the labels and trade dress designed for Maurice Lenell by Ray Braun are within the scope of this order and are confusingly similar to Bader's distinctive trade dress.

Dated this **[2nd]** day of **[Sept]**, 1994.

[Walter T. McGovern]

United States District Judge

Presented by:

CHRISTENSEN, O'CONNOR,
JOHNSON & KINDNESS

(KiSong Kim Lang-Caditz)

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EXHIBIT A2

EXHIBIT A3